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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,400	04/26/2001	Takanori Nishimura	450100-03182	3418
20999	7590	02/09/2006	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			ROHWER, JACOB P	
			ART UNIT	PAPER NUMBER

2624

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/843,400	Applicant(s) NISHIMURA, TAKANORI	
	Examiner Jacob P. Rohwer	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-10,13-19,22-28 and 31-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-10,13-19,22-28 and 31-38 is/are rejected.
- 7) ☒ Claim(s) 1,22-27 and 31-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

Claim 1 is objected to because of the following informalities: Lin 16 claims, "a transmission configured to transmit", examiner believes applicant intends to claim a transmission unit as consistent with the remainder of the units claimed in the apparatus of claim 1. Appropriate correction is required.

Claims 22-27 and 31-36 are objected to because of the following informalities: the claims are either directly, or indirectly dependent upon cancelled claims 20 and 29. Appropriate correction is required. Examiner will assume claim dependency should be directed towards pending amended claims 19 and 28.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 10, 15, 19, 22-25, 28, 31-34, 37, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No 6,775,705 to Maeda, in view of US Patent No 6,457,044 to IwaZaki.

Regarding claim 1, Maeda discloses an information processing apparatus configured to transmit an E-mail information, said E-mail information including an E-mail message body and an attached file to a reception terminal (**Fig 1, Col 3 Lin 42-49**), the apparatus comprising:

an accommodating capability unit configured to verify **(Fig 1 #10)** an information accommodating capability in said reception terminal or in a communication system encompassing said reception terminal, based on an address **(Claim 1 Lin 16-18, destination address)** used in sending the E-mail information to said reception terminal; **(Col 3 Lin 15-18)**

an information converting unit configured to convert the E-mail **(Fig 1 #7, Col 7 Lin 46-50)** information into a format matching the information accommodating capability in said reception terminal or in said communication system encompassing said reception terminal if the information accommodating capability in said reception terminal or in said communication system encompassing said reception terminal is not matched to said E-mail information; **(Col 2 Lin 58-60, Lin 64-67 Col 3 Lin 2)** and

transmission configured to transmit said E-mail information **(Fig 1 #4, #8, #12)**.

Maeda does not expressly disclose that the destination address that determines the reception terminal capability is an E-mail address.

However, IwaZaki discloses an image processing apparatus that determines information accommodating capability of a reception terminal based on an E-mail address. **(Col 3 Lin 45-48)**

The Maeda and the IwaZaki Patents are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use E-mail address designation as specified in the IwaZaki Patent, in order to

determine the information accommodating capability of the reception terminal as specified in Maeda.

The suggestion/motivation for doing so would have been to quickly start and efficiently perform image transmission and avoid time lost when data transmission is not compatible between the transmitting and receiving terminals. **(Col 3 Lin 18-20)**

Regarding claim 6, Maeda further discloses the information processing apparatus according to claim 1 wherein the attached file is an image file. **(Col 3 Lin 43)**

Regarding claim 10, please see rejection of claim 1. Additionally, the apparatus of claim 1 performs the method of claim 10.

Regarding claim 15, which depends from claim 10, please see rejection of claim 6 above. Additionally the apparatus of claim 6 performs the method of claim 15.

Regarding claim 19, please see rejection of claim 1. Additionally, Maeda further discloses a reception terminal **(Fig 1 #2)** including reception unit **(Fig 1 #5)** for receiving said E-mail information sent from said transmission terminal and information opening unit for open the transfer information. **(Fig 1 #12)**

Regarding claim 22, which is assumed to depend from claim 19, please see rejection of claim 4 above.

Regarding claim 23, which depends from claim 22, please see rejection of claim 5 above.

Regarding claim 24, which is assumed to depend from claim 19, please see rejection of claim 6 above.

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Regarding claim 25, which is assumed to depend from claim 19, please see rejection of claim 7 above.

Regarding claim 28, please see rejection of claim 19. Additionally, the system of claim 19 performs the method of claim 28.

Regarding claim 31, which is assumed to depend from claim 28, please see rejection of claim 4 above. Additionally the apparatus of claim 4 performs the method of claim 31.

Regarding claim 32, which is assumed to depend from claim 28, please see rejection of claim 5 above. Additionally the apparatus of claim 5 performs the method of claim 32.

Regarding claim 33, which is assumed to depend from claim 28, please see rejection of claim 6 above. Additionally the apparatus of claim 6 performs the method of claim 33.

Regarding claim 34, which is assumed to depend from claim 28, please see rejection of claim 7 above. Additionally the apparatus of claim 7 performs the method of claim 34.

Regarding claim 37, please see rational provided in the rejection of claims 1 and 10. The apparatus of claim 1 and the method of claim 10 correspond to the medium for causing an information process apparatus to execute a program of claim 37. **(Maeda Col 4 Lin 32-34)**

Regarding claim 38, please see rational provided in the rejection of claims 19 and 28. The apparatus of claim 19 and the method of claim 38 correspond to the

medium for causing an information process apparatus to execute a program of claim 38.

(Col 4 Lin 32-34)

Claims 4, 5, 7, 13-14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Maeda and IwaZaki as specified in claim 1 above, in view of US Patent No 6,775,688 to Kakimoto.

Regarding claim 4, the combination of Maeda and IwaZaki does not expressly disclose the apparatus of claim 1 wherein, if said reception terminal or said communication system encompassing said reception terminal is not matched to the attached file, said information converting unit is configured to include in the E-mail information a statement of a method enabling a user of said reception terminal to confirm the contents of said attached file.

However, Kakimoto discloses an information processing apparatus **(Fig 1)** wherein, if said reception terminal or said communication system encompassing said reception terminal is not matched to the attached file, said information converting unit is configured to include in the E-mail information a statement of a method enabling a user of said reception terminal to confirm the contents of said attached file. . **(Col 2 Lin 27-33, a link to a network where the specified data is stored is distributed to the desired destinations.)** By clicking on a link sent to the reception terminal, distributed data can be accessed when the information accommodating capability is not conducive to the data sent. This would be considered a method enabling a user of said reception terminal to confirm the contents of said file information.

The combination of Maeda and IwaZaki and the Kakimoto Patent are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to inform the reception terminal of the use of an access link to a network as specified in the Kakimoto Patent in order to access data from a reception terminal not capable of accommodating the data at the actual destination of the reception terminal, as specified in the combination of Maeda and IwaZaki.

The suggestion/motivation for doing so would have been to allow the user of the reception terminal to access information even though the reception terminal E-mail cannot accommodate the data designated to be transmitted.

Therefore it would have been obvious to combine the Kakimoto Patent with the combination of Maeda and IwaZaki in order to obtain the invention in claim 4.

Regarding claim 5, the combination of Maeda and IwaZaki does not expressly disclose that if the said reception terminal or said communication system encompassing said reception terminal is not matched to the attached file, said information converting unit sends accessing information to means for saving said attached file in said E-mail as a method enabling the confirmation of the contents of said attached file.

However, Kakimoto discloses an information processing apparatus (**Fig 1**) that if the said reception terminal or said communication system encompassing said reception terminal is not matched to the attached file, said information converting unit sends accessing information to means for saving said attached file in said E-mail as a method

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enabling the confirmation of the contents of said attached file. **(Col 2 Lin 27-33, a link to a network where the specified data is stored is distributed to the desired destinations so that the data can be accessed.)**

The combination of Maeda and IwaZaki and the Kakimoto Patent are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to inform the reception terminal of the use of an access link to a network as specified in the Kakimoto Patent in order to access data from a reception terminal not capable of accommodating the data at the actual destination of the reception terminal, as specified in the combination of Maeda and IwaZaki.

The suggestion/motivation for doing so would have been to allow the user of the reception terminal to access information even though the reception terminal E-mail cannot accommodate the data designated to be transmitted.

Therefore it would have been obvious to combine the Kakimoto Patent with the combination of Maeda and IwaZaki in order to obtain the invention in claim 5.

Regarding claim 7, Maeda further discloses the information processing apparatus according to claim 1 wherein the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal includes a format of the attached file. **(Col 1 Lin 42-46 mention changing image formats and Col 9 Lin 8-10 mentions different image formats)**

Maeda does not expressly disclose the information processing apparatus according to claim 1 wherein the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal includes a maximum size of the E-mail information and a maximum file size of the attached file.

However, Kakimoto discloses an information processing apparatus wherein the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal includes the maximum size of the E-mail information and the maximum file size of the file information. **(Col 2 Lin 27-37)**

There is disclosed a determination means in which the size of the specified data is determined to be smaller or larger than a predetermined size capability of the destination.

The combination of Maeda and IwaZaki and the Kakimoto Patent are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the predetermined size threshold of the specified E-mail data as specified in the Kakimoto Patent in order to determine the information accommodating capability of the reception terminal as specified in the combination of Maeda and IwaZaki.

The suggestion/motivation for doing so would have been to avoid excessive load on the network because a large size of data is transmitted and can't be accommodated. **(Kakimoto, Col 1 Lin 24-27)**

Therefore it would have been obvious to combine the Kakimoto Patent with the combination of Maeda and IwaZaki in order to obtain the invention in claim 7.

Regarding claim 13, which depends from claim 10, please see rejection of claim 4 above. Additionally the apparatus of claim 4 performs the method of claim 13.

Regarding claim 14, which depends from claim 13, please see rejection of claim 5 above. Additionally the apparatus of claim 5 performs the method of claim 14.

Regarding claim 16, which depends from claim 10, please see rejection of claim 7 above. Additionally the apparatus of claim 7 performs the method of claim 16.

Claims 8, 17, 26 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Maeda, IwaZaki, and Kakimoto as specified in claim 7 above, and further in view of US Patent No 6,421,429 to Merritt et al.

Regarding claim 8, the combination of Maeda, IwaZaki and Kakimoto as specified in claim 7 above discloses the information processing apparatus according to claim 6 wherein the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal includes a maximum size of the E-mail, an image format of the attached image file, and a maximum file size of the attached file. Furthermore, IwaZaki discloses an image processing apparatus that determines information accommodating capability of a reception terminal including a maximum pixel size of the image corresponding to said image file. **(Col 5 Lin 50-51 mentions the resolution of the image)**

The combination does not expressly disclose that the information accommodating capability includes a maximum number of colors of the image corresponding to said image file.

However Merritt discloses an image processing apparatus that determines information accommodating capability of a reception terminal including a maximum number of colors of the image corresponding to said image file. **(Col 10 Lin 35-39)**

The Combination of Maeda, IwaZaki and Kakimoto and the Merritt Patent are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the maximum number of colors of the image corresponding to the image file as specified in the Merritt Patent in order to determine the information accommodating capability of the reception terminal as specified in the combination of Maeda, IwaZaki and Kakimoto.

The suggestion/motivation for doing so would have been to allow for correct image processing with respect to colors in the transmission of the image data from a transmitting to a receiving terminal.

Therefore it would have been obvious to combine the Merritt Patent with the combination of Maeda, IwaZaki and Kakimoto in order to obtain the invention in claim 8.

Regarding claim 17, which depends from claim 15, please see rejection of claims 8 and 10 above. Additionally the apparatus of claim 8 performs the method of claim 17.

Regarding claim 26, which depends from claim 24, please see rejection of claim 8 and 10 above.

Regarding claim 35, which depends from claim 33, please see rejection of claims 8 and 10 above. Additionally the apparatus of claim 8 performs the method of claim 35.

Claims 9, 18, 27 and 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Maeda and IwaZaki as specified in claims 1 and 6 above, in view of US Patent Publication No 2001/0039615 to Bowker et al.

Regarding claim 9, the combination of Maeda and IwaZaki discloses the information processing apparatus according to claim 6.

The combination does not expressly disclose the information processing apparatus according to claim 6 wherein, if said image file is a moving image file and the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal corresponds only to a still image file, said information converting means renders one or plural frames making up said moving image file into the attached file attached to said E-mail information.

However, Bowker discloses a data transmission apparatus that translates video to still images when a specific data processing terminal can't accommodate the data format transmitted. **(Para [0001] and Para [0006] Lin 1-10)**

The combination Maeda and IwaZaki and the Bowker Publication are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to translate video to still images as specified in the Bowker Publication in order to convert the image file to be transmitted as specified in the combination of Maeda and IwaZaki.

The suggestion/motivation for doing so would have been to allow for the user of the reception terminal to view the image file when the accommodating capability of the terminal does not allow them to view a video or motion image file.

Therefore it would have been obvious to combine Bowker Publication with the combination of Maeda and IwaZaki in order to obtain the invention in claim 9.

Regarding claim 18, which depends from claim 15, please see rejection of claims 9 and 10 above. Additionally the apparatus of claim 9 performs the method of claim 18.

Regarding claim 27, which depends from claim 24, please see rejection of claims 9 and 10 above.

Regarding claim 36, which depends from claim 33, please see rejection of claims 9 and 10 above. Additionally the apparatus of claim 9 performs the method of claim 36.

Response to Arguments

Applicant's arguments filed on 5 January 2006 have been fully considered but they are not persuasive.

Examiner acknowledges the argument that Maeda does not teach verifying the accommodating capability of the reception terminal based on an E-mail address. The argument further mentions that neither, Bowker, IwaZaki, Kakimoto or Merritt cure the above noted deficiency in Maeda. However, examiner disagrees and has pointed out

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that IwaZaki discloses using the stored destination address of an E-mail in order to determine capability. (**IwaZaki Col 3 Lin 34-48**) As a result the 102 rejection of the first office action has been changed to a 103 rejection, Maeda in view of IwaZaki.

Additionally, applicant argues that Maeda requires three transmissions in order to determine accommodating capabilities. This subject matter is moot in regard to that first, it is not claimed in the amended claims, and second, in Fig 2 S202 of Maeda, it is disclosed that once destination capability data has been stored, there is no longer the need to request the capability. The step then proceeds to simply looking it up in the destination capability storage unit. (**Fig 1 #11, Fig 2 S202**)

Conclusion

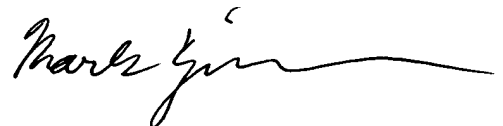
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob P. Rohwer whose telephone number is 571-272-5509. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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